



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,402	08/27/2001	James J. Pagliuca	A31-5822	4330

26294 7590 01/21/2004

TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P.
526 SUPERIOR AVENUE, SUITE 1111
CLEVEVLAND, OH 44114

EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,402

Applicant(s)

PAGLIUCA ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17, 26-38 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 1, 18, 21 and 39 is/are rejected.
- 7) ☒ Claim(s) 2-11, 19, 20, 22-25 and 40-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Konomura (U.S. Pat. 5,575,754) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 3.
3. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima (U.S. Pat. 4,854,301) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 3.
4. Claims 18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Pagliuca (U.S. Pat. 6,530,880) for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 3.

Allowable Subject Matter

5. Claims 12-17, 26-38 and 44-48 are allowed.
6. Claims 2-11, 19, 20, 22-25 and 40-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive. Applicant's arguments did however convince the Examiner that the Konomura reference did not anticipate the structure of claim 8. Therefore, claim 8 is now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant appears to believe that since the preferred intended use of the Konomura device (e.g., for a jet engine) is different from that of Applicant's device (e.g., patient), the structure of Konomura can not anticipate the structure of claim 1. The Examiner respectfully disagrees. The intended use of the device can not define structurally over a prior art structure, especially when the prior art structure is capable of such intended use.

Furthermore, Applicant argues that the Konomura reference "does not describe or suggest a base for association with the cannula". Konomura does indeed show a base, as described in the rejection of claim 1, so the Examiner assumes that Applicant is concentrating on the language "for association with the cannula". Although Applicant fails to explain how this language is to be interpreted (i.e., whether this language is *intended* to positively recite the cannula as part of the claimed combination or not), it must be pointed out that claim 1, as it is presently worded, does not require the cannula, as well as the endoscope, in the combination of positively claimed elements. These elements are recited functionally. The cannula is not brought into the combination until claim 4 which recites a positive connection with the cannula. Therefore, since a cannula is capable of being "associated" with the base of Konomura, the base of Konomura anticipates the base as broadly as claimed.

The above positions apply to similar arguments made with respect to other rejected claims and other references, where applicable.

As to claim 18, the Examiner submits that this claim also fails to positively recite either the cannula or endoscope as part of the covered combination of elements. Thus, Applicant's arguments concerning Konomura not showing the structure in relation to these elements is moot. The Examiner takes the position that the structure of Konomura is at least capable of such interconnection. In addition, Applicant argues that pin (22) is not "press fit" into groove (21) in the Konomura device "since the fixing member moves relative to the pin". Please note that this is no different than Applicant's sleeve (600) moving relative to the member (720).

With respect to the Pagliuca reference, Applicant confusingly states that this reference does not describe a "sleeve retainer for supporting a sleeve and a base". Note numbered paragraph 7 of the previous Office Action which specifically points to the sleeve retainer (125). The rejection also specifically points out detent member (420) which Applicant surprisingly states "is not press fit onto an end portion of the sleeve". If a spring loaded detent mechanism can not be considered to be "press fitted" then the Examiner doesn't know what is.

It is noted that claim 26 was indicated as allowable in the previous Office Action. However, Applicant amended such claim. The nature of the amendment to this claim does not effect the Examiner's position with respect to the prior art of record.

With respect to the Nakajima reference, it is noted again that the cannula and endoscope are not being positively recited. Nakajima shows each and every claim element of claim 39.

Conclusion

Art Unit: 3739

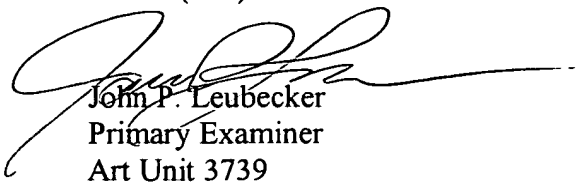
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


John P. Leubecker
Primary Examiner
Art Unit 3739

jpl